## REMARKS

This Response, submitted in reply to the Office Action dated October 14, 2005, is

believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable

reconsideration on the merits is respectfully requested.

Claims 1-51 are all the claims pending in the application.

### I.      Claim Rejections under 35 U.S.C. § 103

Claims 1-51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over

McGraw-Hill Primis Custom Publishing (www.mhhe.com/primis), archived circa 1998, via the

Wayback Machine (www.archive.org) (hereinafter "McGraw-Hill"), in view of Helmick et al.

(hereinafter "Helmick"), U.S. Patent No. 6,470,171. Applicant respectfully traverses the

rejection.

McGraw-Hill is cited for teaching all elements of claim 1, for example, except for

"defining the first content object by a first outline of containers and content entity identifiers,

such that adding the content entity identifier of one of the second plurality of content entities to

the first outline adds the identified content entity to the first content object at a location

determined by a user." The Examiner cites Helmick as disclosing that missing limitation. The

Examiner asserts that the combination of Helmick with McGraw-Hill is obvious in order to build

a custom hierarchical outline compilation of educational materials. However, as discussed

below, McGraw-Hill and Helmick do not disclose all of the claimed elements. Further, there is

no teaching or suggestion in the prior art to combine Helmick with McGraw-Hill as the

Examiner asserts.

The Examiner asserts that the content to be placed in a customized book in Mc-Graw can be mixed and matched in any order, therefore, McGraw-Hill discloses *"adding* the content entity identifier of one of the second plurality of content entities to the first list adds the identified content entity to the first content object *at a location determined by a user."* However, there is no indication in McGraw-Hill that a user determines the location of a content entity identifier when adding a content entity identifier of a second content entity to a first content object. Assuming *arguendo* McGraw-Hill discloses a customized book, the location of the content entity identifier added to the first content object appears to be determined *subsequent to* the addition of the content entity identifier to the first content object.

In particular, the McGraw-Hill reference appears to show that a user browses for desired subject matter and then selects "Add" to add the content to their customized book. After adding the content, the user then has the option of reviewing the selected content and resequencing the content as necessary as shown by the "resequencing" control illustrated in the upper right hand corner of the figures. However, there is no teaching or suggestion that *"adding* the content entity identifier of one of the second plurality of content entities to the first list adds the identified content entity to the first content object *at a location determined by a user."*

The Examiner further asserts that Helmick teaches an on-line education system for display of education materials wherein a user can use a course manager screen in order to build an electronic syllabus. Figs. 3V-3X of Helmick. The Examiner reasons that the combination of "defining a first object by a first list of content entity identifiers organized as an outline of containers such that adding the content entity identifier of one of the second plurality of content entities to the first list outline adds the identified content entity to the first content object at a

location determined by a user" as allegedly disclosed in Helmick, with the teachings of McGraw-Hill would be obvious to one of skill in the art for the motivational purpose of building a custom hierarchical outline compilation of educational materials.

However, Figs. 3V-3X of Helmick cited by the Examiner do not disclose the relationship between a first content object and a second content object as recited in claim 1. Fig. 3X shows an "add contents screen" 1084 for use by an instructor to "add or modify content." However, the content added to a syllabus as illustrated in Fig. 3V (which the Examiner appears to be citing for teaching a first content object) is not a content entity identifier of one of a second plurality of content entities but rather is the content itself. Accordingly, modifying McGraw-Hill based on Helmick would result merely in providing McGraw-Hill with an "add contents screen" that would allow an instructor to type in the actual content to be added. The combination would not, however, add a content identifier of one of a second plurality of content entities to the first list outline, as required by claim 1. Moreover, Helmick does not cure the deficiencies of McGraw-Hill.

The Examiner asserts that "storing of the first plurality of content entities in a data repository" is taught by the custom book of McGraw-Hill that is created by a user. However, as previously asserted by the Applicant, there is no indication that the custom book created by a user is stored in the Primis database (data repository as cited by the Examiner). In response to Applicant's argument that although the customized entities of McGraw-Hill must be stored in some kind of memory, there is no teaching or suggestion that the first plurality of content entities (the customized book according to the Examiner) is stored in the data repository, namely, the Primis database, as asserted in the Office Action, the Examiner "agrees that the customized book

does not "necessarily" <u>have</u> to be stored in the Primis database, although it can be." Further, the

Examiner states that it is commonly well known that a customized book must be stored in some

kind of memory, therefore, the Examiner asserts that this limitation of the claims is therefore

deemed inherent.

However, "[i]n relying upon the theory of inherency, the examiner must provide a basis

in fact and/or technical reasoning to reasonably support the determination that the allegedly

inherent characteristic *necessarily flows* from the teachings of the applied prior art." *Ex parte

Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).  According to the Examiner's own

statements, the customized book (first content object as cited by the Examiner) could be stored in

locations other than the Primis database.  Consequently, this aspect of the claim is not inherent.

For at least the above reasons, claims 1, 6, 16, 21, 31 and 36 and their dependent claims
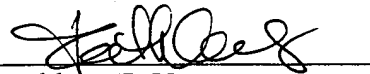
should be deemed allowable.

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited.  If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880.  Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

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WASHINGTON OFFICE
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